REMARKS

The Office action has been carefully considered. The Office action rejected claims 1, 2, 6, 51, 54, 55, 58, 61, 62, 64, 72, 74, and 75 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,860,342 to Danner et al. ("Danner"). Further, the Office action rejected claims 1-17, 44, 51, 54-64, and 68-75 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,240,168 to Stanford et al. ("Stanford"). Further yet, the Office action rejected claims 3-5, 7-9, 14-26, 28, 31, 33, 36, 37, 41, 42, 47, 49, 56, 57, 60, 63, and 65-71 under 35 U.S.C. § 103(a) as being unpatentable over Danner. Still further, the Office action rejected claims 27, 29, 30, 32, 34, 35, 38, 39, 43, 45, 46, 48, 50, 52, and 53 under 35 U.S.C. § 103(a) as being unpatentable over Danner in view of U.S. Patent No. 6,603,855 to Cannon et al. ("Cannon") and in further view of U.S. Patent No. 6,518,957 to Lehtinen et al. ("Lehtinen"). The Office action rejected claims 18-26, 28, 31, 33, 36, 37, 40-42, 47, 49, and 65-67 under 35 U.S.C. § 103(a) as being unpatentable over Stanford. Finally, the Office action rejected claims 27, 29, 30, 32, 34, 35, 38, 39, 43, 45, 46, 48, 50, 52, and 53 under 35 U.S.C. § 103(a) as being unpatentable over Stanford in view of Cannon and in further view of Lehtinen. Applicants respectfully disagree.

Claims 1, 54, 62, 73, and 75 are independent claims. By present amendment, claims 1, 54, 62, 73, and 75 have been amended for clarification and not in view of the prior art. Claim 74 has been cancelled. Applicants submit that the claims as filed were patentable over the prior art of record, and that the amendments herein are for purposes of clarifying the claims and/or for expediting allowance of the claims and not for reasons related to patentability. Reconsideration is respectfully requested.

Prior to discussing reasons why applicants believe that the claims in this application are clearly allowable in view of the teachings of the cited and applied references, a brief description of the present invention is presented.

The present invention is directed to a system and method for including telephony controls for handling telephony applications on a personal computer with integrated telephony capabilities. Such a personal computer may be connected to telephone equipment for accepting incoming calls of various kinds such as analog Public Switched Telephone Network (PSTN), private branch exchange (PBX), cellular telephony or VoIP. To this end, the computer is generally arranged as a central communications point for multiple communications-related devices. Accordingly, the present invention provides an enhanced user interface with telephony controls for such a computer so that users may activate and interact with telecommunications applications such as handling phone calls and voice mail.

The telephony controls may include a hook switch, a talk button, a speakerphone button, a mute button, a flash button, a conference button, a microphone button, and a voice mail button. There may also be other telephony control buttons, such as an optional record button in close proximity to the telephony controls for use in responding to voice mail. Because the state of an individual telephony control button may not be readily apparent to a user, an indicator light such as an LED may be located adjacent to or integrated into each telecommunication control button as appropriate. Additionally, there may be a single hook indicator light alternatively used. Furthermore, although an operating system typically handles telephony controls, the computer system need not be fully operational for the telephony controls to work in accordance with the present invention. Indeed, some of the controls may work when the computer is powered down, at least to a default extent or to an extent configured by a user. For example, the user may want the telephony controls to work as a conventional appliance when the main processor of the computer system is powered down (e.g., in a suspend, sleep or off state), so that the user may answer incoming calls using the telephone handset, speakerphone and caller-ID device. Further, the user may limit the extent of the communications based on the computer system state, *e.g.*, when the user is not logged in, long distance calls may be blocked, calls to a certain prefix may be blocked, and so forth. Any tasks that do not require a running operating system or application program similarly may remain operational and use the telephony controls when the operating system or application program is not available or in standby mode. See specification, page 30, second paragraph.

The system and method allow a number of user interaction scenarios with respect to real-time communications, including handling an incoming telephone call and making a telephone call. To make a telephone call, the user lifts the handset or presses the talk button or presses the speakerphone button, and then dials a number. Alternatively, the user may select a contact using a graphical user interface or employ voice dialing. While on a call, a user may switch the active receiver to a speakerphone or other receiver such as a handset or headset. The user may decide to switch the system audio input device from the handset or headset to a computer microphone. A user may also perform tasks such as switching lines using the flash button to answer a waiting call or toggling a call hold state by actuating the hold button. The user can also perform other communications-related tasks, including conference calling and checking voice mail. Whenever a new voice mail message arrives, an indicator light may blink to notify the user, whereby the user can press the voice mail button to access voice mail.

Note that the above description is for example and informational purposes only, and should not be used to interpret the claims, which are discussed below.

§102 Rejections

Turning to the claims, amended claim 1 essentially recites a general purpose computer system for executing a telephony application, comprising an application having telephony functionality for handling telephony-related communication signals when the computer system is operating in a main processor powered-on state, in which the computer system further functions as a conventional telephone appliance when in a main processor powered-down state (e.g., a sleep / suspend state or completely off).

The Office action rejected claim 1 as being anticipated by both Danner and Stanford. More specifically, the Office action contends that Danner teaches a general purpose computer system for executing a telephony application, comprising an application having telephony functionality. Figs. 1, 2, and 4 and column 4, lines 29-43 of Danner are referenced. Further, the Office action contends that Danner teaches a telephony control for inputting a command. Column 4, lines 29-43 of Danner is referenced. Further yet, the Office action contends that Danner teaches an operating system having a component operably coupled to the telephony control and the application, the component receiving the input command from the telephony control and sending the input command to the application. Column 4, lines 8-16, column 5, lines 41-60, and column 8, line 3 to column 10, line 50 of Danner are referenced.

Similarly, the Office action contends that Stanford teaches a general-purpose computer system for executing a telephony application, comprising an application having telephony functionality. Figs. 3A-3F of Stanford are referenced. Further, the Office action contends that Stanford teaches a telephony control for inputting a command. Figs. 3A-3F of Stanford are referenced. Further yet, the Office action contends that Stanford teaches an operating system having a component operably coupled to the telephony control and the application, the component receiving the input command from the telephony control and sending the input command to the application. Column 6, line 47 to column 7, line 63 of Stanford is referenced. Applicants respectfully disagree.

Danner is directed generally, to a system for realizing a telephone communication system in the form of a personal computer. As such, a general purpose computer is enabled to perform telephone functions such as dialing, answering lines, and placing lines on hold. Similarly, Stanford also discloses a computer system for realizing a software telephone displayable on a display that may replace a desktop telephone. However, both Danner and Stanford are silent with respect to the ability of the computer-implemented telephone to function when the computer system (e.g., the main processor thereof) is powered off.

In contrast, claim 1 recites an application having telephony functionality for handling telephony-related communication signals when the computer system is operating in a main processor powered-on state and that functions as a conventional telephone appliance when in a main processor powered-down state. Danner specifically states that the main computer power is required for operation of any kind. See column 6, lines 34-38 of Danner. Likewise, Stanford teaches actually displaying the telephony function on the display for use. Thus, if the system is not powered on, then there is no way to realize any telephony functions, as nothing is displayed to a user. Simply stated, neither of the systems of Danner or Stanford can realize any telephone functions when in a powered-down state as is recited in claim 1. Applicants submit that claim 1 is allowable over the prior art of record for at least the foregoing reasons.

Applicants respectfully submit that dependent claims 2-17, 44, and 51, by similar analysis, are allowable. Each of these claims depends either directly or indirectly from claim 1 and consequently includes the recitations of independent claim 1. As discussed above, both Danner and Stanford, individually, fail to teach the recitations of claim 1 and therefore these dependent claims are also allowable. In addition to the recitations of claim 1 noted above, each of these dependent claims includes additional patentable elements.

For example, claim 4 recites the telephony functionality comprises placing a call on hold. Further, claim 12 recites the telephony functionality comprises conferencing in a telephone call from a second line to a telephone call on a first line. Further yet claim 16 recites the telephony functionality comprises muting the audio during the telephone call. Each of these functions is not taught by Stanford or Danner within the context of the system of claim 1.

Turning to the next independent claim, amended claim 54 essentially recites receiving a telephone call on one of a plurality of communications networks, routing the telephone call to a computer system operable to handle telephony-related communication signals, if the computer system is in a main processor powered-on state, then detecting actuation of a telephony control requesting to take the receiver off-hook to answer the telephone call, and in response, connecting the call, and detecting the receiver in an on-hook state, and in response, terminating the telephone call. However, when the computer system is in a main processor powered-down state, the telephone call is passed to a conventional telephone appliance of the computer system that remains operational in this state.

The Office action rejected claim 54 as being anticipated by both Danner and Stanford. More specifically, the Office action cites the same sections of both Danner and Stanford as were cited with respect to the rejection of claim 1. As before, applicants respectfully disagree.

Both Danner and Stanford are directed generally, to a system for realizing a telephone communication system in the form of a personal computer. As such, a general-purpose computer is enabled to perform telephone functions such as dialing, answering lines, and placing lines on hold. However, both Danner and

Stanford are silent with respect to the ability of the computer-implemented telephone to function when the computer system is powered off.

In contrast, claim 54 is generally directed towards detecting activation of telephony control if the computer system is in a powered-on state, and passing the telephone call to a conventional appliance when in a powered-off state. Danner specifically states that power is required for operation of any kind. See column 6, lines 34-38. Likewise, Stanford teaches actually displaying the telephony function on the display for use; thus, if the system of Stanford is not powered on, then it is unusable. There is simply no teaching or suggestion of any way to pass telephony calls through the respective systems of Danner and Stanford when in a powered-down state, in contrast to the subject matter recited in claim 54. Applicants submit that claim 54 is allowable over the prior art of record for at least the foregoing reasons.

Applicants respectfully submit that dependent claims 55-61, by similar analysis, are allowable. Each of these claims depends either directly or indirectly from claim 54 and consequently includes the recitations of independent claim 54. As discussed above, both Danner and Stanford individually fail to teach the recitations of claim 54 and therefore these dependent claims are also allowable over the prior art of record. In addition to the recitations of claim 54 noted above, each of these dependent claims includes additional patentable elements.

Turning to the next independent claim, amended claim 62 is generally directed towards handling calls both in the powered-on and powered-off states. However, as discussed above, both Danner and Stanford, whether considered individually or in any permissible combination, are silent with respect to the ability of the computer-implemented telephone to function when the computer system is powered off, (and if anything actually teach away from such a system).

Both the systems of Danner and Stanford cannot pass any telephone calls when in a powered-down state, which is different from the recitations of claim 62. Applicants submit that claim 62 is allowable over the prior art of record for at least these foregoing reasons.

Applicants respectfully submit that dependent claims 63-64 and 68-72, by similar analysis, are allowable. Each of these claims depends either directly or indirectly from claim 62 and consequently includes the recitations of independent claim 62. As discussed above, both Danner and Stanford individually fail to teach the recitations of claim 62 and therefore these dependent claims are also allowable over the prior art of record. In addition to the recitations of claim 62 noted above, each of these dependent claims includes additional patentable elements.

Turning to the next independent claims, claims 73 and 75 are also generally directed to the concept involving the computer system / programs with telephony operation when powered on, yet allowing conventional operation of a computer system telephone when powered off. The Office action rejected claim 73 as being anticipated by Stanford, and claim 75 as being anticipated by both Danner and Stanford. More specifically, the Office action cites the same sections of the prior art as were cited with respect to the rejection of claim 1. As before, applicants respectfully disagree.

Once again, claims 73 and 75 are generally directed towards different kinds of telephony-related functionality when in a powered-on state versus a powered-down state. Danner and/or Stanford are each completely silent with respect to any functionality that may be implemented in a powered-down state. Applicants submit that claims 73 and 75 are allowable over the prior art of record for at least the foregoing reasons.

§103 Rejections

The Office action rejected claims 3-5, 7-9, 14-39, 41-43, 45-50, 52, 53, 56, 57, 60, 63, and 65-71 as being unpatentable over Danner alone or Danner in combination with Cannon and/or Lehtinen. Applicants respectfully disagree.

To establish *prima facie* obviousness of a claimed invention, all of the claim recitations must be taught or suggested by the prior art; (*In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)), and "all words in a claim must be considered in judging the patentability of that claim against the prior art;" (*In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). Further, if prior art, in any material respect teaches away from the claimed invention, the art cannot be used to support an obviousness rejection. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed Cir. 1997). Moreover, if a modification would render a reference unsatisfactory for its intended purpose, the suggested modification / combination is impermissible. See MPEP § 2143.01.

Applicants submit that the Office action has failed to establish a *prima facie* case for obviousness. Each of these claims depends from an independent claim that has been amended to have recitations that are not taught or suggested by the prior art of record. As such, these claims are also allowable over the prior art of record at least because these claims are based upon an allowable independent claim. As was shown above, Danner does not teach the recitations of independent claims 1, 54, or 62. Thus, even if the alleged combination is permissible (which applicants submit it is not), Danner cannot possibly teach or even suggest the recitations of these claims even when the references of Cannon and Lehtinen are introduced. Applicants submit that these claims are allowable over the prior art of record for at least these reasons.

Additionally, The Office action rejected claims 18-43, 45-50, 52-53, and 65-67 as being unpatentable over Stanford alone or over Stanford in combination with Cannon and/or Lehtinen.

Applicants submit that the Office action has failed to establish a *prima facie* case for obviousness. Each of these claims depends from an independent claim that has been amended to have recitations that are not taught or suggested by the prior art of record. As such, these claims are also allowable over the prior art of record at least because these claims are based upon an allowable independent claim. As was shown above, Stanford does not teach the recitations of independent claims 1, 54, or 62. Thus, even if the alleged combination is permissible (which applicants submit it is not), Stanford cannot possibly teach or even suggest the recitations of these claims even when the references of Cannon and Lehtinen are introduced. Applicants submit that these claims are allowable over the prior art of record for at least these reasons.

CONCLUSION

In view of the foregoing remarks, it is respectfully submitted that claims 1-73 and 75 are patentable over the prior art of record, and that the application is in good and proper form for allowance. A favorable action on the part of the Examiner is earnestly solicited.

If in the opinion of the Examiner a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney at (425) 836-3030.

Respectfully submitted,

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In re Application of Bear et al.
Serial No. 10/677,084

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this Response, along with transmittal, petition for extension of time, credit card payment form, and facsimile cover sheet, are being transmitted by facsimile to the United States Patent and Trademark Office in accordance with 37 C.F.R. 1.6(d) on the date shown below:

Date: December 7, 2005

Albert S. Michalik
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3890 Amendment